

# 28

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**KEATING & BENNETT LLP****Fax****RECEIVED****JUL 16 2003****Technology Center 2800****To:** Examiner T. Nguyen**From:** Christopher A. Bennett**Fax:** 703-872-9317**Date:** July 16, 2003

2800- Customer Service

**Phone:****Pages:** 11**Re:** 09/401,080**CC:**

36856.218

**•Comments:**

Examiner Nguyen,

*These papers are being  
treated as a petition to  
W/D the Holding of Abandonment.*

We have received a Notice of Abandonment dated 07/15/2003 in the above-identified application. After carefully reviewing our file, we note that a Request for Reconsideration was timely filed on June 11, 2003.

Please find attached the following documents for Application No. 09/401,080 that were filed on June 11, 2003:

1. Request for Reconsideration;
2. Petition for three-month extension of time; and
3. Credit card form payment in the amount of \$930.00.

In addition, we include a copy of the following documents:

4. A copy of the Auto-Reply Facsimile Transmission; and
5. A copy of the Notice of Abandonment dated 07/15/2003.

Respectfully submitted,



Christopher A. Bennett

for

KEATING & BENNETT, LLP  
(Reg. No. 46,710)

06/11/03 11:49:40

USPTO-&gt;

7033855080 Right 'X'

Page 001

TO: Auto-reply fax to 7033855080 COMPANY:

## Auto-Reply Facsimile Transmission



TO:

Fax Sender at 7033855080

Fax Information

Date Received:

6/11/03 11:44:40 AM [Eastern Daylight Time]

Total Pages:

8 (including cover page)

**ADVISORY:** This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMPE) section 306 et seq.

Received  
Cover  
Page

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06/11/2003 10:45	7033855080	KEATING & BENNETT	PAGE 01/08
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**KEATING & BENNETT LLP**

## Fax

To: Examiner T. Nguyen	From: Christopher A. Bennett
Fax: 703 478-4318	Date: June 11, 2003
Re: 08/401,080	Pages: 8
36558,218	CC:

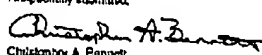
Comments:

Examiner Nguyen,

Please find attached the following documents for Application No. 08/401,080:

1. Request for Reconsideration
2. Petition for three-month extension of time; and
3. Credit card form payment in the amount of \$390.00.

Respectfully submitted,

  
Christopher A. Bennett  
for  
KEATING & BENNETT, LLP  
(Reg. No. 45,710)

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being transmitted to  
Group Art Unit 2832, 703-872-9318, addressed to:  
Commissioner for Patents, P.O. Box 1450, Alexandria, VA  
22313-1450.

Date: June 11, 2003

  
Sonia V. McVean

**PATENT**  
36856.218

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Takashi SHIKAMA et al.	Art Unit: 2832
Serial No.: 09/401,080	
Filed: September 22, 1999	Examiner: T. Nguyen
Title: COMPOSITE INDUCTOR ELEMENT	

**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated December 13, 2002, the period for response to which has been extended to June 13, 2003, by the accompanying Petition for a THREE-month Extension of Time, please reconsider the above identified application in view of the following remarks.

Claims 1 and 3-11 are pending in this application.

Claims 1 and 3-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 8-306570 in view of JP 63-79306 and JP 3-171702. Applicants respectfully traverse the rejection of claims 1 and 3-11.

Claim 1 recites:

"A composite inductor element comprising:  
a block made of at least either resin or rubber having a magnetic material dispersed therein, external electrodes being provided on said block; and  
a plurality of spirally wound coils buried in said block, end portions

Serial No. 09/401,080

June 11, 2003

Reply to Office Action dated December 13, 2002

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of each of the plurality of coils being electrically connected to said external electrodes; wherein

the plurality of coils are arranged such that axes of all of the plurality of coils extend substantially parallel to one another; and

**at least one of said plurality of coils has a different electrical characteristic produced by at least one of (1) a different number of windings of said at least one of said plurality of coils from that of the remainder of said plurality of coils, (2) a different thickness of said at least one of said plurality of coils from that of the remainder of said plurality of coils, (3) a different diameter of said at least one of said plurality of coils from that of the remainder of said plurality of coils, and (4) a different space between wound sections of said at least one of said plurality of coils from that of the remainder of said plurality of coils."** (emphasis added)

Applicants' claim 1 recites the features of "at least one of said plurality of coils has a different electrical characteristic produced by at least one of (1) a different number of windings of said at least one of said plurality of coils from that of the remainder of said plurality of coils, (2) a different thickness of said at least one of said plurality of coils from that of the remainder of said plurality of coils, (3) a different diameter of said at least one of said plurality of coils from that of the remainder of said plurality of coils, and (4) a different space between wound sections of said at least one of said plurality of coils from that of the remainder of said plurality of coils." With the improved features of Applicants' claim 1, Applicants have been able to provide a composite inductor element which has a significantly reduced cost and greatly reduced space requirement (see, for example, the second full paragraph on page 2 of the Specification).

Applicants agree with the Examiner that JP 08-306570 shows an inductor and does not teach or suggest the claimed composite material or that at least one of the electrical coils has a different electrical characteristic from the other coils as recited in Applicants' claim 1.

The Examiner has relied upon JP 63-079306 to allegedly teach the claimed composite material of resin or rubber having a magnetic material dispersed therein. The Examiner has alleged that it would have been obvious to one of ordinary skill in the

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June 11, 2003

Reply to Office Action dated December 13, 2002

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art to modify JP 08-306570 "for the purpose of enhancing the inductance of the device" (second paragraph on page 3 of the Office Action). Applicants respectfully disagree.

Applicants are completely bewildered as to what "enhancing the inductance" means. This phrase does not appear anywhere in the English language abstract of JP 63-079306. "Enhancing the inductance" is a very broad motivation, and the Examiner has completely failed to explain why one of ordinary skill in the art would have specifically modified the core body 7 of JP 08-306570 to be made of the resin 2 mixed with ferrite powder of JP 63-079306, especially in view of the fact that the core body 7 of JP 08-306570 is inserted into the coil 5 shown in Fig. 5 of JP 08-306570 and the coil 1 of JP 63-079306 is entirely embedded in the resin 2 mixed with ferrite powder.

The Examiner is reminded that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987).

Accordingly, Applicants respectfully submit that the Examiner has not provided proper motivation for combining the teachings of JP 08-306570 and JP 63-079306.

In fact, JP 63-079306 and JP 08-306570 cannot be combined as suggested by the Examiner. JP 08-306570 teaches in the English language abstract that the inductor must be "burned," that is sintered. However, JP 63-079306 teaches in the English language abstract the use of an resin epoxy mixed with "sintered fine ferrite powder" which is "heated and fused and is then hardened," that is cured and set. The epoxy resin mixed with "sintered fine ferrite powder" of JP 63-079306 cannot be used in the device of JP 08-306570 because the epoxy resin of JP 63-079306 cannot be sintered because of the high temperatures involved with sintering. If the resin mixed with the sintered fine ferrite powder of JP 63-079306 were sintered, the resulting inductor element would be completely inoperable.

As clearly explained above, JP 08-306570 and JP 63-079306 diverge from each other so much so that they cannot be combined, and also diverge from Applicants'

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June 11, 2003

Reply to Office Action dated December 13, 2002

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claimed invention. The Examiner is reminded that it is error to find obviousness where references diverge and teach away from the invention at hand. W.L. Gore & Assoc. v. Garlock Inc., 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983).

Further, the Examiner has relied upon JP 03-171702 to allegedly teach the feature that at least one of the electrical coils has a different electrical characteristic from the other coils as recited in Applicants' claim 1. Specifically, the Examiner alleged that JP 03-171702 teaches the use of coils with different diameters and refers to **Fig. 5** of JP 03-171702. However, **Fig. 5** of JP 03-171702 is a close up view of the material 24, with **A** being the metallic magnetic powder, **B** being the electrical insulating film, and **C** being the electrical insulating powdery binder material, **NOT different coil sizes** as recited in Applicants' claim 1. In fact, there is absolutely nothing in JP 03-171702 that teaches or suggests different coil sizes as recited in Applicants' claim 1.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a) as being obvious over JP 08-306570 in view of JP 63-079306 and JP 03-171702.

Accordingly, Applicants respectfully submit that JP 08-306570, JP 63-079306, and JP 03-171702, applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in claim 1 of the present application. Claims 2-10 depend upon claim 1, and are therefore allowable for at least the reasons that claim 1 is allowable.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

To the extent necessary, Applicants petition the Commissioner for a THREE-month extension of time, extending to June 13, 2003, the period for response to the Office Action dated December 13, 2002.

Serial No. 09/401,080  
June 11, 2003  
Reply to Office Action dated December 13, 2002  
Page 5 of 5

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: June 11, 2003

  
Attorneys for Applicant

Joseph R. Keating  
Registration No. 37,368

Christopher A. Bennett  
Registration No. 46,710

**KEATING & BENNETT LLP**  
10400 Eaton Place, Suite 312  
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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being transmitted to  
Group Art Unit 2832, 703-872-9318, addressed to: Commissioner  
for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: June 11, 2003

  
Sonia V. McVean

**PATENT**  
36856.218

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Takashi SHIKAMA et al.	Art Unit: 2832
Serial No.: 09/401,080	Examiner: T. Nguyen
Filed: September 22, 1999	
Title: COMPOSITE INDUCTOR ELEMENT	

**PETITION FOR EXTENSION OF TIME**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.136(a), Applicants hereby petition for a THREE-month extension of time to respond to the outstanding Office Action dated December 13, 2002, or until June 13, 2003.

Enclosed is a Credit Card Payment form for \$930.00 to pay the THREE-month extension fee in accordance with Rule 1.17(a)(3).

The Commissioner of Patents is authorized to charge any amount due, or credit any overpayment, to Deposit Account No. 50-1353.

Respectfully submitted,

Dated: June 11, 2003

  
Attorneys for Applicants

Joseph R. Keating  
Registration No. 37,368

Christopher A. Bennett  
Registration No. 46,710

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PTO-2038 (02-2000)  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

# UNITED STATES PATENT & TRADEMARK OFFICE

## Credit Card Payment Form

Please Read Instructions before Completing this Form

### Credit Card Information

Credit Card Type: ☐ Visa ☐ Master Card ☒ American Express ☐ Discover

Credit Card Account #: 3715 318560 12013

Credit Card Expiration Date: 05/2004

Name as it Appears on Credit Card: Christopher A. Bennett

Payment Amount: \$ (US Dollars): \$930.00

Signature:

*Christopher A. Bennett*

Date: June 11, 2003

**Refund Policy:** The Office may refund a fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts (37 CFR 1.26). Refund of a fee paid by credit card will be via credit to the credit card account.

**Service Charge:** There is a 50.00 service charge for processing each payment refused (including a check returned "unpaid") or charged back by a financial institution (37 CFR 1.21 (m)).

### Credit Card Billing Address

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Street Address2: Suite 312

City: Arlington

State: VA

Zip/Postal Code: 22202

Country: U.S.A.

Daytime Phone #: (703) 385-5200

Fax #: (703) 385-5080

### Request and Payment Information

Description of Request and Payment Information:

Petition for THREE Month Extension of Time

Patent Fee	Patent Maintenance Fee	Trademark Fee	Other Fee
Application No. 09/401,080	Application No.	Serial No.	IDON Customer No.
Patent No.	Patent No.	Registration No.	
Attorney Docket No. 36856.218		Identify or Describe Mark	

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## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,080	09/22/1999	TAKASHI SHIKAMA	36856.00218	4173

7590 07/15/2003  
JOSEPH R KEATING ESQ  
INTELLECTUAL PROPERTY GROUP  
10400 Eaton Place Suite 312  
fairfax, VA 22030

EXAMINER

NGUYEN, TUYEN T

ART UNIT PAPER NUMBER

2832

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Abandonment**Application No.  
09/401,080Applicant(s)  
Shikama et al.Examiner  
Tuyen T. NguyenArt Unit  
2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on Dec 13, 2002.
- (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
- (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113(a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
- (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
- (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
- (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
- (b) ☐ The submitted issue fee of \$ \_\_\_\_\_ is insufficient. A balance of \$ \_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$ \_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d) is \$ \_\_\_\_\_.
- (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
- (a) ☐ Proposed new formal drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
- (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interferences rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.